

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-AUBERT BARRA
and RENE PAILLOT

Appeal No. 96-2271
Application 07/995,047¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, and ABRAMS
and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed December 22, 1992.

This is an appeal from the decision of the examiner finally rejecting claims 1, 2, 5 through 8, 11 and 14. At that point, claims 15 through 43 had been canceled, claims 44 through 77 had been allowed, and claims 3, 4, 9, 10, 12 and 13 had been indicated as being allowable if recast in independent form. Subsequently, in the Answer, the examiner withdrew the rejection of claims 5 and 14, indicating that they also would be allowable if recast in independent form. Therefore, remaining before us on appeal are claims 1, 2, 6 through 8 and 11.

The appellants' invention is directed to a ventricular cannulation device. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A ventricular cannulation device for providing communication through an opening in the cardiac wall comprising:

an outer part, for placement on the cardiac wall, having a first central opening and a first means for catching onto said cardiac wall;

an inner part having a size suitable for placement in the cardiac chamber, having a second central opening and second means for catching onto the cardiac wall and means for guiding and attaching said outer part; and

a tube corresponding to the openings of said cardiac wall and inner and outer parts and serving as a support for a vascular prosthesis.

THE REFERENCES

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The references relied upon by the examiner to support the final rejection are:

Sugarbaker	2,638,901	May 19, 1953
Zeman	3,540,451	Nov. 17, 1970

THE REJECTIONS

Claims 1, 2 and 6 through 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sugarbaker.

Claims 1, 2, 6 through 8 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zeman.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d

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1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). It also does not require that the reference

teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

The first of the anticipation rejections is based upon Sugarbaker. We share the examiner's view that all of the structure recited in claim 1 reads on the Sugarbaker clamp. Using the language of claim 1 as a guide, Sugarbaker discloses a device which in our view clearly appears to be capable of providing communication through a wall of body tissue. It comprises an outer part 7, which could be placed on the outer surface of a tissue wall, and it has a first central opening

(through which tube 4 passes) and a first means for catching onto a tissue wall, in the form of needles 22. It further comprises an inner part 2 having a second central opening 13 and a second means for catching onto a tissue wall (a second set of needles 22). Elements 10 and 19, respectively, provide means for guiding and attaching the outer part into engagement with the inner part. Lastly, Sugarbaker discloses a central tube 4 offering access through the device into the chamber beyond.

It is true that the Sugarbaker device is not disclosed as a ventricular cannulation device for providing communication through an opening in the cardiac wall, as is recited in the preamble to the appellants' claim 1. However, while the appellants have argued that it should be disqualified as a reference because it is not suitable for use in a cardiac environment, no evidence has been made of record to support such a position. We see no reason why the Sugarbaker device, which clearly catches both faces of bowel tissue, would not also be capable of catching both sides of cardiac tissue. Likewise, we see no reason why its size would not be suitable for placement in a cardiac chamber.

It is our opinion that the subject matter recited in claim 1 is anticipated by Sugarbaker, and we therefore will sustain the rejection of claim 1 on that basis.

Claim 2 adds to claim 1 the requirement that the second catching means be "in the form of a plurality of claws." We agree with the appellants that the Sugarbaker needles are not claws within the definition established by the appellants' specification, and we therefore will not sustain the Section 102 rejection of claim 2. Nor, it follows, will we sustain the rejection of claim 6, which depends from claim 2.

Dependent claim 7 adds to claim 1 the qualification that the outer part be "disk-shaped." We do not find this to be the case in Sugarbaker, wherein the outer part has the shape of a half of a sphere. The rejection of claim 7, and further dependent claim 8, therefore is not sustained.

The second rejection of claim 1 is that it is anticipated by Zeman. However, while Zeman discloses tissue catching means on the outer part of the device, it fails to disclose the required "second means for catching" on the inner part. We do not subscribe to the examiner's hypothesis that this shortcoming is

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overcome by utilizing the Zeman device with the inner and outer parts reversed.

The rejection of the claims as being anticipated by Zeman is not sustained.

With regard to the Sugarbaker rejection of claim 1, we have carefully considered all of the appellants' arguments, but they have not persuaded us that the examiner here was in error. Our position with regard to these arguments should be apparent.

Summary:

The rejection of claim 1 as being anticipated by Sugarbaker is sustained.

The rejection of claims 2 and 6 through 8 as being anticipated by Sugarbaker is not sustained.

The rejection of claims 1, 2, 6 through 8 and 11 as being anticipated by Zeman is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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